

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DANIEL P. STACHOWICZ,
BRITT HASLOW,
KATHIE WEBER,
and
HOWARD W. WURSTER, JR.,
APPELLANTS

Appeal 2008-1071
Application 09/940,805¹
Technology Center 1700

Decided: 31 March 2008

Before ADRIENE LEPIANE HANLON, CAROL A. SPIEGEL, and
ROMULO H. DELMENDO, *Administrative Patent Judges*.

SPIEGEL, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ Application 09/940,805 ("the 805 Application") filed 29 August 2001. The real party in interest is said to be Rich Products Corporation (Appeal Brief filed 20 November 2006 ("App. Br."), 2).

I. Statement of the Case

Daniel P. Stachowicz, Britt Haslow, Kathie Weber, and Howard W. Wurster, Jr. ("Appellants") appeal under 35 U.S.C. § 134 from the rejection of claims 1-12 and 14-20, all of the pending claims. We have jurisdiction under 35 U.S.C. § 6(b). We AFFIRM.

The subject matter on appeal relates to a decorator coupler having a tip capable of providing a filling, such as frosting or soft food, in a first desired shape and also capable of retaining a second tip for providing the filling in a second desired shape. Claim 1 is illustrative and reads:

1. An integrated decorator coupler for insertion into a bag fabricated to hold filling, comprising:

a hollow shaft having a non-decorative opening for receiving filling; and

a decorative tip extending from and integral with the hollow shaft, wherein the decorative tip has a non-circular decorative opening designed to extrude filling in a first non-cylindrical decorative shape; and

means provided on an exterior of the shaft to engage a second decorative tip for extruding filling in a second decorative shape. [App. Br., 7.]

The Examiner relies on the following references² as evidence of unpatentability:

Hueg	560,719	May 26, 1896
Ekdahl	2,103,111	Dec. 21, 1937
Wechsler	2,320,496	Jun. 1, 1943
Moore	2,419,654	Apr. 29, 1947
Loucony	2,928,533	Mar. 15, 1960

² No references to *et al.* are made in this opinion.

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Setecka	2,945,458	Jul. 19, 1960
Lacey	2,968,262	Jan. 17, 1961
Schultz	3,191,809	Jun. 29, 1965
Parrish	3,847,523	Nov. 12, 1974
DeLorimiere	4,844,917	Jul. 4, 1989
Hawley	5,104,013	Apr. 14, 1992
Shannon	6,153,238	Nov. 28, 2000
Knight	6,179,165 B1	Jan. 30, 2001
Niggemyer	2003/0205584 A1	Nov. 6, 2003
Berrod ³	FR 598,674	Dec. 22, 1925
Janik ⁴	EP 340 132 A1	Nov. 2, 1989
Craig	GB 2 237 224 A	May 1, 1991
Ooms	EP 757 006 A1	Feb. 5, 1997

The Examiner has rejected claims 1-12 and 14-20 under 35 U.S.C.

§ 103(a) as unpatentable over Shannon as evidenced by Janik, in view of Craig, Schultz, Ekdahl, Lacey, Loucony, Setecka, and Hueg, further in view of Ooms, Berrod, Parrish, Wechsler, DeLorimiere, Moore, Knight, Niggemyer, Appellants' admission of the prior art, and Hawley (Ans.,⁵ 2-3).

Appellants have not provided separate patentability arguments for any of claims 1-12 and 14-20 (App. Br., 4-6). A statement which merely points out what a claim recites is not an argument for separate patentability of the claim. 37 C.F.R. § 41.37(c)(1)(vii). The only arguments we consider on

³ This decision cites the February 2007 English translation of Berrod by the Ralph McElroy Translation Company.

⁴ This decision cites the March 2007 English translation of Janik by the McElroy Translation Company.

⁵ According to page 3 of the Examiner's Answer filed 15 March 2007 ("Ans."), "[t]he one and only rejection set forth in the Final Rejection mailed 7/26/06 is withdrawn in favor of the new ground of rejection stated above. Note, however, that this new ground of rejection is the same rejection, employing the same references for the same reasons, as found in the Final Rejection of 7/26/06, except for the addition of Hawley."

appeal are those made in the Appeal Brief. 37 C.F.R. § 41.37(c)(1)(vii) (2006). All other arguments which could have been made, but were not made, are waived. Therefore, we decide this appeal on the basis of claim 1. 37 CFR § 41.37(c)(1)(vii).

II. Findings of Fact ("FF")

The following findings of fact and any set out in the Discussion are supported by a preponderance of the evidence of record.

A. The 805 Application

- [1] In one embodiment, the 805 specification describes a food decorating assembly comprising a decorator coupler 10 protruding from a lower aperture 41 in a bag 40 capable of holding food filling (Spec., 5).
- [2] The decorator coupler 10 comprises a hollow tubular main body 11 which includes an externally threaded portion 15 for engaging a decorative tip 20, a decorative opening 12 (food outlet), and a non-decorative opening 13 for connecting to the bag 41 (food inlet) (Spec., 4-5; Figs. 1 and 2).
- [3] Since "the decorator coupler has a decorative opening, the food decorating assembly does not require any additional decorative tips" (Spec., 6).
- [4] However, decorator coupler 10 allows the user to use different decorating tips, if so desired, "to decorate food in shapes different than the shape defined by the decorative opening 12 of the decorator coupler 10" (*id.*).
- [5] According to the 805 specification, "[d]ecorative tips are available in different sizes and shapes, which provide for a wide range of food decorating options" (Spec., 1).

B. Shannon

- [6] In one embodiment, Shannon discloses a food package assembly comprising an adaptor **141** protruding from a lower aperture in a pouch **120** containing a packaged cheese product (Shannon, 6:48-65; Figs. 5 and 6).
- [7] Adaptor **141** comprises a hollow tubular main body which includes an externally threaded portion for engaging a decorator tip **145** having a desired shape with a retaining nut **143**, an opening with an adaptor shoulder **142** for connecting the adaptor **141** to pouch **120** at one end of the tube (food inlet), and a circular opening at the other end of the tube (food outlet) (*id.*).
- [8] In another embodiment, Shannon discloses a food package assembly comprising a decorative tip **40** protruding from a lower aperture in a pouch **20** containing a packaged cheese product (Shannon, 4:13-22; Figs. 1, 2 and 4).
- [9] Decorative tip **40** comprises a hollow tubular main body having an opening with a shoulder **42** for connecting the tip **40** to the pouch **20** at one end of the tube (food inlet), and non-circular opening **44** at the other end of the tube (food outlet) (*id.*).

C. Knight

- [10] Knight discloses a pastry bag assembly comprising a bag **20** having a threaded adaptor/flexible receptacle member **22** designed to engage a threaded upper end **51** of an optional decorative tip **50** having non-circular tip **52** (Knight, 2:1-51; Fig. 3).

- [11] The contents of the pastry bag may be dispensed directly from the threaded adaptor/receptacle member **22** or from the optional decorative tip **50** (Knight, 1:64-65; 2:1-3; Figs. 1 and 3).

D. Hawley

- [12] Hawley discloses a caulking tube nozzle adaptor **24** provided with a reducing coupling **26** or a plurality of successively interconnected reducing couplings such as **26** and **28**, or **26**, **28** and **30**, for providing adjustable exit opening sizes (Hawley, 1:55-59; 2:64-68; Figs. 2 and 4).

E. Cumulative references

- [13] The following references also disclose nozzles or tips having round or circular openings for producing decorative exudates:

Craig (Craig, 4:10-15; Figs. 2-3);
Schultz (Schultz, 3:55-66; Figs. 3-4, elements **35b** and **35c**);
Ekdahl (Ekdahl, 1:39-40; Fig. 3);
Lacey (Lacey, 3:22-36; Fig. 2);
Loucony (Loucony, 2:33-35; Fig. 1);
Setecka (Setecka, Fig. 8, elements 23b and 23c); and,
Hueg (Hueg, Fig. 1).

- [14] The following references also disclose nozzles or tips having non-circular openings for producing decorative exudates:

Janik outlet orifice **6** (Janik, 4; Figs. 3-4);
Craig (Craig, 4:20-26; Figs. 4-6);
Schultz (Schultz, 3:55-66; Figs. 3-4, elements **35a** and **35d**);
Ekdahl (Ekdahl, 1:41-48; Figs. 4-6);
Lacey (Lacey, 3:22-36; Fig. 2);

Loucony (Loucony, 2:33-35; Fig. 1);
Setecka (Setecka, Fig. 8, elements 23d-23i);
Hueg (Hueg, Figs. 5-7);
Ooms (Ooms, Figs. 4-5);
Parrish (Parrish, Figs. 1-7);
Wechsler (Wechsler, 2:53 through 3:3; Figs. 3, 5 and 6);
Moore (Moore, 2:2-8; Figs. 4-9);
Knight (Knight, Fig. 3); and,
Appellants' admitted state of the prior art (Spec., 1 ("Decorative tips are available in different sizes and shapes, which provides for a wide range of food decorating options.")).

- [15] The following references also disclose decorator tips directly attached to a bag/pouch of a food package assembly:
- Janik (Janik, Fig. 2);
DeLorimiere (DeLorimiere, 4:28-36); and,
Niggemyer (Niggemyer, ¶23).
- [16] The following references also disclose decorator tips attached via adaptors/couplers to a bag/pouch of a food package assembly:
- Berrod (Berrod, 1-2; Fig. 2); and,
Parrish (Parrish, 1:32-59; Figs. 2 and 6).

III. Discussion

A. The Examiner's findings and conclusions

The Examiner has rejected claims 1-12 and 14-20, in the alternative, over each of two embodiments disclosed by Shannon (Ans., 5-10). In one embodiment, the Examiner found that Shannon discloses a coupler 141 comprising (i) a hollow shaft having a non-decorative opening for receiving

filling at one end, (ii) a tip extending from and integral with the hollow shaft at the other end; and, (iii) a means on the exterior of the shaft, i.e., screw threads, to engage a decorative tip capable of extruding filling in a shape different from the coupler (Ans., 5). The Examiner found that this embodiment of Shannon differed from the claimed invention in having a tip with a circular opening, rather than a non-circular opening as recited in claim 1, extending from and integral with the hollow shaft (Ans. 5).

The Examiner found that Knight teaches extruding icing directly through a coupler or optionally with an additional nozzle if a different decorative shape is desired (Ans., 11). The Examiner found that each of Craig, Schultz, Ekdahl, Lacey, Loucony, Setecka and Hueg teaches decorator nozzles or extruders with round or circular openings; while each of Janik, Craig, Schultz, Ekdahl, Lacey, Loucony, Setecka, Hueg, Ooms,⁶ Berrod, Parrish, Wechsler, Moore, Knight and Appellants' admitted prior art teaches that decorator nozzles or extruders with non-circular openings are notoriously well known in the art for food decorating (Ans., 5-6).

The Examiner concluded that it would have been obvious to modify the coupler of Shannon by employing a non-circular, rather than circular, cross sectional shaped extruder outlet to enable it to produce a shape corresponding to the shape of the outlet since Knight teaches extruding a filler directly through a coupler and the cumulative prior art teaches using any shape decorative tip or nozzle desired as a function of the design desired (Ans., 7 and 11).

⁶ The Examiner did not point out, and we did not find, where Ooms discloses nozzles or tips having non-circular openings for producing decorative exudates.

As to Shannon's alternative embodiment, the Examiner found that decorative tip 40 illustrated in Figure 7 of Shannon differed from the integrated decorator coupler of claim 1 "in that the decorator tip does not contain coupling means (i.e. threads) for coupling other, differently shaped outlets, extruder nozzles/tips" (Ans., 8). The Examiner concluded that it would have been obvious to provide this embodiment of Shannon with thread-type, coupling means so that one could use the tip immediately and have the capability of using differently shaped openings to produce differently shaped/sized products as taught by Shannon and the prior art taken as a whole (Ans., 8-9).

According to the Examiner,

there appears to be sufficient teaching in Shannon itself to modify the coupling and provide a different shape or size output in view of Shannon's other embodiment, the secondary art can, in any case, be relied on to teach both the problem and its solution. That is, the prior art teaches that any conduit can impart a shape to an extruded product by providing the outlet opening of the conduit with the appropriate shape, that one can provide outlet nozzles with threads to attach other differently shaped or sized nozzles thereto, and that a coupler can be used as the outlet opening without an attached additional, differently shaped outlet element. [Ans., 12.]

The Examiner newly relies on Hawley as disclosing that "it was conventional to provide a plurality of thread containing extruder nozzles or tips having differently sized outlet openings so that one nozzle could be associated with another to change an aspect of the extruded material, i.e. its size" (Ans., 8).

B. Appellants' arguments and supporting evidence

As to Shannon's first embodiment, Appellants argue that (i) there is no motivation to substitute the circular opening of Shannon's coupler with a non-circular decorative opening and (ii) doing so would defeat the primary purpose of using couplers in the prior art to maximize the amount of filling extruded from a bag with a minimum effort by the user (App. Br., 4-5; Reply Br.,⁷ 2-3). Appellants rely on a Declaration under 37 C.F.R. § 1.132 by Howard Wurster, Jr. ("Declaration") to support their position.

- [17] Mr. Wurster testified that use of a non-circular opening in Shannon's coupler "would increase the amount of resistance created by the opening and thereby run counter to the intended purposes of the couplers of Shannon and the other couplers in the cited references" (Declaration, ¶ 4).
- [18] Mr. Wurster further testified that, in his opinion, one of ordinary skill in the art would not have been motivated to modify "the large circular coupler opening described and illustrated in Shannon to the non-circular decorative opening of the claimed invention" (Declaration, ¶ 4).
- [19] Mr. Wurster still further testified that, in his opinion, "there would not be a reasonable expectation of successfully making such a modification" since, generally, "the more intricate the decorative shape, the greater the resistance encountered" (Declaration, ¶ 5).

Appellants also refer to Exhibit A attached to their principal Brief as showing that couplers are designed to allow filling to flow to a tip with a minimum amount of resistance, i.e., "the diameter D of the adapter 141 of

⁷ Reply Brief filed 15 May 2007 ("Reply Br.").

Shannon shown in FIG. 5 is larger than the diameter d of the decorative tip 40 shown in FIG 4. (The designations "D" and "d" have been added by Applicants for identification purposes)." (App. Br., 5). Finally, Appellants argue that the Examiner repeatedly misconstrues a "decorative tip" to equate to any conduit outlet (Reply Br., 4).

As to Shannon's alternative embodiment, Appellants argue that (iii) there is no identified motivation for modifying the decorative tip shown in Figure 7 of Shannon to allow it to accept a second decorator tip on top of it (App. Br., 5; Reply Br. 3).

C. Legal standards

Claims are given their broadest reasonable interpretation consistent with the specification. *In re Prater*, 415 F.2d 1393, 1404-05 (CCPA 1969) (unpatented claims given broadest reasonable construction consistent with specification).

A claimed invention is not patentable if the subject matter of the claimed invention would have been obvious to a person of ordinary skill in the art. 35 U.S.C. § 103(a); *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1734 (2007); *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). Facts relevant to a determination of obviousness include (1) the scope and content of the prior art, (2) any differences between the claimed invention and the prior art, (3) the level of ordinary skill in the art, and (4) any relevant objective evidence of obviousness or nonobviousness. *KSR*, 127 S.Ct. at 1734; *Graham*, 383 U.S. at 17-18.

A person having ordinary skill in the art uses known elements and process steps for their intended purpose. *Anderson's-Black Rock, Inc. v. Pavement Salvage Co.*, 396 U.S. 57 (1969) (use of radiant-heat burner for its

intended purpose held to be obvious); *Sakraida v. AG Pro, Inc.*, 425 U.S. 273, 282 (1976) (the involved patent simply arranges old elements with each performing the same function it had been known to perform); *Dunbar v. Myers*, 4 Otto (94 U.S.) 187, 195 (1875) (ordinary mechanics know how to use bolts, rivets, and screws and it is obvious that any one knowing how to use such devices would know how to arrange a deflecting plate at one side of a circular saw which had such a device properly arranged on the other side).

D. Analysis

In our opinion, the Examiner has presented sufficient factual findings and reasoning to support a *prima facie* case of obviousness; and, Appellants have not shown that the Examiner has committed reversible error in so doing.

As an initial matter, Appellants' argument that the Examiner has misconstrued the meaning of a "decorative tip" as recited in the claimed invention is not well taken for two reasons. The 805 specification fails to provide a specific definition of a "decorative tip" which excludes certain conduit outlet shapes. The 805 specification expressly indicates that the decorator coupler is a decorative tip *per se* since it has a decorative opening and does not require any additional decorative tip (FF 3). Appellants have failed to establish that a tip having a circular opening is not a decorative tip as defined in the specification.

As to the rejection based on modifying coupler 141 of Shannon, Appellants have failed to show lack of motivation or lack of a reasonable expectation of success of substituting a non-circular extrusion outlet for the disclosed circular extrusion outlet of coupler 141. The evidence of record

indicates that the size and shape of an extrusion outlet is determined by the design of the extrusion product desired (FF 13-14) and that a coupler may function as a decorator tip *per se* (FF 11). The Examiner has provided a well reasoned, factually-supported basis for the proposed modification, i.e., choosing a decorative tip based on the desired design of the extrudate (Ans., 7 and 11).

Neither Appellants nor Mr. Wurster have pointed to evidence of record establishing that couplers cannot be used as a decorator tip *per se* and/or must have a circular outlet opening for operability. Additionally, arguments based on drawings not explicitly made to scale are unavailing. *In re Wright*, 569 F.2d 1124, 1127 (CCPA 1977) ("Absent any written description in the specification of quantitative values, arguments based on measurements of a drawing are of little value."). Rather, it appears reasonable, but not outside of ordinary skill in the art, for a user to exert more force (to overcome more resistance) to push a filling in a bag through one end of a coupler attached to the bag (inlet) and out the other end of the coupler if the extrusion outlet has a smaller cross-sectional area than its inlet. Assuming the inlet opening is a circular opening, it also appears irrelevant whether the decreased cross-sectional area of the outlet vis-à-vis the inlet is due to the outlet being a circular opening of smaller relative diameter or being a more intricate opening. "A person of ordinary skill in the art is also a person of ordinary creativity, not an automaton." *KSR*, 127 S.Ct. at 1742. Here, the modification suggested by the Examiner merely substitutes one simple element, a decorator tip having a non-circular opening, for another, a decorator tip having a circular opening, to obtain a predictable result, i.e., an extrusion product having a desired shape.

Similarly, as to the rejection based on modifying the decorative tip shown in Figure 7 of Shannon, contrary to Appellants' arguments, the Examiner expressly found that "it was conventional to employ coupler threads on nozzles so that additional threaded nozzles, having different outlets, can be coupled to the threaded, coupler nozzle (e.g., Hawley)" (Ans. 16).

Appellants argue that a caulking device, e.g., described by Hawley, is so fundamentally different that one of ordinary skill in the art would not have been motivated to use its teachings of multiple couplers or, alternatively if he/she did, the skilled artisan would have been motivated to use multiple couplers, not a single integrated coupler (Reply Br., 2). However, Hawley, like the other prior art relied upon by the Examiner, is directed to providing an adaptor nozzle which permits the user to switch between variously selected extrusion shapes for different applications. Additionally, in common with Shannon, Hawley discloses a plurality of threads as a means for engaging a second decorative tip/coupler. The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. *In re Young*, 927 F.2d 588, 591 (Fed. Cir. 1991); *In re Keller*, 642 F.2d 413, 425 (CCPA 1981). In evaluating such references it is proper to take into account not only the specific teachings of the references but also the inferences which one skilled in the art would reasonably have been expected to draw therefrom. *In re Preda*, 401 F.2d 825, 826 (CCPA 1968). Here, as noted by the Examiner, Hawley suggests using a plurality of threads as a means for engaging a second decorative tip to the tip shown in Figure 7 of Shannon. Therefore, these arguments are not persuasive of patentability.

Accordingly, based on the foregoing, we AFFIRM the rejection of claims 1-12 and 14-20 under § 103(a) as unpatentable over Shannon as evidenced by Janik, in view of Craig, Schultz, Ekdahl, Lacey, Loucony, Setecka, and Hueg, further in view of Ooms, Berrod, Parrish, Wechsler, DeLorimiere, Moore, Knight, Niggemyer, Appellants' admission of the prior art, and Hawley.

IV. Order

Upon consideration of the record and for the reasons given, it is ORDERED that the decision of the Examiner rejecting claims 1-12 and 14-20 under 35 U.S.C. § 103(a) as unpatentable over Shannon as evidenced by Janik, in view of Craig, Schultz, Ekdahl, Lacey, Loucony, Setecka, and Hueg, further in view of Ooms, Berrod, Parrish, Wechsler, DeLorimiere, Moore, Knight, Niggemyer, Appellants' admission of the prior art, and Hawley is AFFIRMED; and,

FURTHER ORDERED that no time period for taking any subsequent action in connection with this appeal may be extended under 35 U.S.C. § 1.136(a) (2006).

AFFIRMED

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